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QUESTIONS CONCERNING THE PRIORITY DATE

Memorandum prepared by the International Bureau

1. In the seventh session (November 1976) of the Interim Advisory Committee for Administrative Questions (hereinafter referred to as "the Interim Committee"), various questions concerning the priority date--as defined in Article 2(xi)--were discussed, including, in particular, what the "priority date" is when there are several priority claims in the international application some or all of which are defective; whether the applicant has the right to withdraw any priority claim made in the international application; and, if so, what the consequences of such withdrawal would be (see the report of the said session, document PCT/AAQ/VII/19, paragraphs 34 to 39).
2. In conclusion, the Interim Committee decided, in fact, that the International Bureau should study these questions in cooperation with the United States Patent and Trademark Office and that the study should, if necessary, contain proposals for possible solutions.
3. The International Bureau had several consultations with representatives of the said Office. The present document is largely based on such consultations but does not necessarily reflect the views of the said Office. Still, it should be noted that, on the question of the withdrawal of a priority claim, the views expressed in this memorandum are closer to those expressed, in the said session of the Interim Committee, by the delegation of the United States of America (see paragraph 38 of the cited document) than to those expressed by the representative of the International Bureau (see paragraph 36 of the cited document).
4. As to the question what the "priority date" is in the various factual situations expressly covered by Rule 4.10, it would seem that answers follow from a relatively easy application of the text of Rule 4.10, particularly paragraph (e) of that Rule. The Annex to this memorandum tries to enumerate these factual situations and indicates for each case the answer to the question what is the "priority date." It is believed that, for the reason already stated, these answers need not be incorporated in the Administrative Instructions.
5. As far as the question of the withdrawal of the priority claim is concerned, the following considerations are offered as the result of the study of the International Bureau.
6. It would seem to be logical to allow the applicant to withdraw (or "cancel"; the difference is merely terminological) the priority claim, or, where the international application claims the priorities of several earlier applications, any (including all) of such claims.

7. Giving such a possibility to the applicant seems to be logical for at least two reasons. One is that the applicant has the greater right of withdrawing the international application itself; thus the lesser right of withdrawing the priority claim would seem to be covered and justified by the said greater right. The other is that the concept of "cancellation" of the priority claim is already admitted, namely, in Rule 4.10(d); it is true that, there, one speaks about cancellation of a defective claim but if the applicant has the right to the cancellation of a defective claim, then, it would seem, he should, a fortiori, have the right to the cancellation of a claim which is not defective.

8. Admittedly, the cancellation of the priority claim would retard the "priority date," within the sense of Article 2(xi), and could do so by as much as a year, with the consequence that various obligations of the applicant--particularly the payment of national fees and the furnishing of translations of his application--as well as the right of the designated Offices to start national processing, would be retarded by the same period of time.* However, such a delay would not seem to be contrary to the interest either of the public in general or the applicant's competitors in particular; the public would still have access to the technical information contained in the application, albeit somewhat later (whereas if the application is withdrawn, the possibility of access to such information is lost for good since no publication would take place), and the competitors would see the applicant taking a risk, namely, that, for events that have occurred during what would have been the priority period, the invention which is the subject matter of the application may be found to have lost novelty, etc. If, exceptionally, the national processing in a particular designated State has, on the initiative of the applicant, already started earlier and before the date, at which the withdrawal of the priority claim was made, that withdrawal has, unless otherwise prescribed under national law, no legal effect in that designated State. The conditions for, and the effect of, the withdrawal of a priority claim in the national phase, i.e., after the processing of the application before the designated Office has started, are a matter to be determined by national law. In the normal situation where national processing has not yet started, the delay is legally indifferent to the designated Offices. The same applies to elected Offices, since, naturally, the withdrawal of the priority claim could only have effect for elected Offices before which the national processing or examination had not yet started. The International Searching Authorities will not be disturbed by a change in the "priority date" since their search covers, in any case, disclosures that have occurred up to the international filing date, a date which is not changed by a change in the "priority date." The work of International Preliminary Examining Authorities might occasionally be affected; but any slight inconveniences caused for their procedure are more than outweighed by the advantages of the possibility of withdrawal for the applicant.

9. It would seem logical to allow the withdrawal of the priority claim as long as the international processing continues, in other words, until the expiration of the normal time limits during which the national procedure is suspended (Article 23(1) in conjunction with Article 22(1) and (2); Article 40(1) in conjunction with Article 39(1)). If, in any designated or elected Office, the national processing of the application has started (either on the request of the applicant or because the application has been declared unsearchable by the International Searching Authority), the international processing, for the purposes of the State of such an Office, will be over, and the question whether and, if so, with what consequences, the "priority date" may be changed, shall no longer depend on the PCT but on the national law of that State.

10. It would seem that such a time limit needs to be fixed in the Regulations, since, at least in theory, one could imagine other time limits for the purpose. The right, itself, to withdraw the priority claim seems to be inherent and thus would need no express mention. However, if, as is proposed, the Regulations are completed by fixing the time limit, one might just as well, at the same time, mention the right itself. Consequently, a new Rule could be inserted in the Regulations, reading as follows:

* Certain obligations in the procedure before the International Bureau--for example, transmittal of the record copy under Rule 22--would, of course, be similarly retarded. In the case of the transmittal of the record copy, the International Bureau would calculate the time for transmittal having regard to any withdrawal of the priority claim(s) and, if necessary, rescind any notification as to the international application being considered withdrawn which it may have given on the basis of the time limit for transmittal being calculated from the filing date of an earlier application referred to in a withdrawn priority claim.

"Rule 32bis

"Withdrawal of the Priority Claim

"32bis.1 Withdrawal

"(a) The applicant may, within the time limits provided for in Article 22(1) and (2), withdraw the priority claim in the international application. If the applicant has made a demand for international preliminary examination, the withdrawal of the priority claim may be effected within the time limit provided for in Article 39(1).

"(b) Where the international application contains more than one priority claim, the applicant may exercise the right provided for in paragraph (a) in respect of one, more, or all of them.

"(c) Where the withdrawal of the priority claim or any of several priority claims causes a change in the priority date of the international application, any time limit computed from the priority date shall be computed from the changed priority date.

"(d) As to withdrawal within the time limits provided for in paragraph (a), the provisions of Rule 32.1(c) and (d) and of Rule 75.1(b), 75.2 and 75.3, respectively, shall apply mutatis mutandis."

11. Rule 4.10(d) provides for the cancellation or correction of a priority claim which is obviously defective because the filing date indicated in the priority claim precedes the international filing date by more than one year. Such a correction takes place upon the invitation of the receiving Office, or, if the receiving Office has failed to issue an invitation, of the International Bureau. The receiving Office would normally note any defect under Rule 4.10(d), particularly as regards any indicated filing date that it would consider using as the priority date of the international application. For similar reasons, any such defect would also be noted by the International Bureau following the transmittal of the international application to it by the receiving Office. Of course, the invitation could also result from the applicant himself having brought to the attention of the receiving Office (or of the International Bureau) the defect in his priority claim.

12. Rule 4.10(d), however, does not cover the analogous situation of a filing date indicated in a priority claim, which is also obviously defective because it is after the international filing date. Such a situation would occur less frequently than that covered by Rule 4.10(d) and would probably only result from an erroneous indication (whereas the situation under Rule 4.10(d) may arise from a change in the international filing date)--probably of the year or the month of the filing of the earlier application. Nevertheless, for the reasons mentioned in relation to Rule 4.10(d), the receiving Office or the International Bureau would note the defect. It would be in the interests particularly of the applicant and the receiving Office (since that Office will generally notice the defect first) that the priority claim be either corrected or cancelled. The procedure provided under Rule 4.10(d) would be appropriate to achieve such cancellation or correction. The wording of Rule 4.10(d) would, however, need to be changed slightly in order to apply to both situations; instead of referring to a date indicated in the request "which precedes the international filing date by more than one year" as at present, it would have to refer to a date "which does not fall within the period of one year preceding the international filing date." The necessary amendment to Rule 4.10(d) is indicated below with omitted parts shown within square brackets and additions shown underlined.

"4.10(d)

If the filing date of the earlier application as indicated in the request does not fall within the period of one year preceding [precedes] the international filing date [by more than one year], the receiving Office, or, if the receiving Office has failed to do so, the International Bureau, shall invite the applicant to ask either for the cancellation of the declaration made under Article 8(1) or, if the date of the earlier application was indicated erroneously, for the correction of the date so indicated. If the applicant fails to act accordingly within 1 month from the date of the invitation, the declaration made under Article 8(1) shall be cancelled ex officio. The receiving Office effecting the correction or cancellation shall notify the applicant accordingly and, if copies of the international application have already been sent to the International Bureau and the International Searching Authority, that Bureau and that Authority. If the correction or cancellation is effected by the International Bureau, the latter shall notify the applicant and the International Searching Authority accordingly."

13. Another case which would seem to require an express provision in the Regulations, is that of correction by the applicant of a priority date inside the priority year which was erroneously indicated. Errors in the indication of a priority date which is inside the priority year will, normally, not be obvious. Nevertheless, there is an interest of the applicant in correcting them already in the international phase of the procedure, in particular, since the time limits counting from the priority date may be substantially affected. Theoretically, there are two cases: the priority date is, after correction, still inside the priority year or it precedes the filing date by more than one year. The latter case may be disregarded here, because, if discovered by the applicant, it would lead rather to a withdrawal of the claim than to a correction or, if a correction were attempted nevertheless, to a cancellation of the priority claim under Rule 4.10(d). A new provision would, however, appear to be necessary in order to allow correction of the priority date inside the priority year. Whether such correction has legal effect in the procedure before the designated Offices, is of course a question to be determined in the course of that procedure. The new provision could read as follows:

"4.10(d)bis

Where paragraph (d) is not applicable and the filing date of the earlier application, as indicated in the request, was indicated erroneously, the applicant may correct it within the applicable time limit under Rule 32bis.1, provided the corrected filing date precedes the international filing date by not more than one year. Paragraphs (b), (c) and (d) of Rule 32bis.1 shall apply mutatis mutandis with the proviso that, where, as a consequence of the correction of the priority date, a time limit would already have expired without having been complied with or would expire less than one month from the date at which the correction is made, that time limit shall be extended by one month from the latter date."

[Annex follows]

ANNEX

1. No Defect, or No Remaining Defect, under Rule 4.10(b)

1.1 Where the international application indicates one priority application the filing date of which* does not precede the filing date of the international application** by more than one year,

"the priority date" is the filing date of the priority application.

1.2 Where the international application indicates several priority applications having different filing dates,

(i) all of which* do not precede the filing date of the international application** by more than one year,

"the priority date" is the filing date of that priority application which has the earliest filing date;

(ii) some of which precede the filing date of the international application by more than one year but the filing date of one of which* does not precede the filing date of the international application** by more than one year,

"the priority date" is the filing date of that priority application whose filing date does not precede by more than one year the filing date of the international application;

(iii) some of which precede the filing date of the international application by more than one year but the filing date of several of which* do not precede the filing date of the international application** by more than one year,

"the priority date" is the filing date of that one among the priority applications whose filing date does not precede by more than one year the filing date of the international application and which has the earliest filing date.

2. Defect under Rule 4.10(b)

2.1 Where the international application indicates one priority application without indicating the country in which (or at least one country for which) it was filed and/or the date on which it was filed,

"the priority date" is the filing date of the international application.

2.2 Where the international application indicates several priority applications having different filing dates, and the references

(i) to all lack the indication of the country in which (or at least one country for which) they were filed and/or the dates on which they were filed,

"the priority date" is the filing date of the international application;

(ii) to some lack the indication of the country in which (or at least one country for which) they were filed and/or the dates on which they were filed but the reference to one contains both the indication of the country in which (or at least one country for which) it was filed and the date on which it was filed,

"the priority date" is the filing date of that priority application the reference to which contains both the said indications;

* After possible correction under Rule 4.10(d)

** After possible change in that date, e.g., under Article 14(2)

- (iii) to some lack the indication of the country in which (or at least one country for which) they were filed and/or the dates on which they were filed but the references to several others contain both the indication of the country in which (or at least one country for which) they were filed and the dates on which they were filed,

"the priority date" is the filing date of that priority application which, among all the priority applications the references to which contain both the said indications, has the earliest filing date.

[End of Annex and of document]